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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,633	02/20/2004	Katsuhiro Kobayashi	042126	4158

38834 7590 12/14/2004

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
1250 CONNECTICUT AVENUE, NW  
SUITE 700  
WASHINGTON, DC 20036

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/781,633

Applicant(s)

KOBAYASHI ET AL.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/20/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

This Office action is responsive to communication received 02/20/2004 – application papers filed, IDS.

Claims 1-12 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Vincent. As to claim 1, Vincent shows a face section having a striking surface, a sole, a crown, a back, a toe and a heel, all these elements of which are a part of any hollow metal wood-type club head. Note the weight (12, 13) secured nearer the face (Figure 25). As to claim 2, weights (12, 13) are indeed arranged in the crown section. As to claim 3, there are a plurality of weights in the crown, as evidenced by weights (12, 13). As to claim 7, note the further weight (11) in the sole area in Figure 25.

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Teramoto. As to claim 1, Teramoto shows a face section having a striking surface, a

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sole, a crown, a back, a toe and a heel, all these elements of which are a part of any hollow metal wood-type club head. Note Figure 7f showing a weight (1) on the inside of the crown (5) and located nearer the striking face (8). As to claim 2, here again, the weight is in the crown section. As to claims 4 and 5, Teramoto shows that the claimed loft angles are well-known (col. 7, TABLE II).

Claims 1, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasebe. As to claim 1, Hasebe shows a face section having a striking surface, a sole, a crown, a back, a toe and a heel, all these elements of which are a part of any hollow metal wood-type club head. Note the weights (A, C). As to claim 6, the weights are welded to the club head main body (col. 3, lines 60-61). As to claim 8, the weight (A) for example weighs 9 grams (col. 4, line 21) and includes a center that is set back roughly 20 mm from the face (Figure 4). The width of the head from face to back is between 70-127 mm, since it is clear that the distance remaining beyond and to the rear of the 69 mm shown in Figure 4 must be roughly equal to about 20 mm. Thus, all the limitations of claim 8 are anticipated by Hasebe.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teramoto in view of Vincent and Hasebe. Teramoto differs from the claimed invention in that Teramoto does not show the specific combination of locations for the placement of the weights (claims 9, 10) and further does not show the specific dimensional limitations for the mass (claims 11, 12). Note, Teramoto does indicate that the location of the weights and the mass of each weight depends upon the loft angle of the club head. Manipulating the weights (location and mass) enables the skilled artisan to alter

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the impact force imparted to a struck ball (col. 3, lines 1-33). Vincent provides the deficiency in Teramoto in part by noting that weights may be selectively placed in any one of a number of combinations including the crown, back, heel and toe (Figures 7-22). For a reason similar to Teramoto, the patent to Vincent teaches that the placement of the weights affects the impact characteristics of the head (col. 4, lines 7-14). In addition, Hasebe shows that it is old in the art to position at least one added weight closer to the plane of the striking face, specifically within about 20 mm, thereby meeting the claimed limitation of claims 11 and 12 that the weight is separated from the face plane by an amount between 5 mm and 60 mm. Further, Hasebe teaches that the width of the head from front to rear be dimensioned within the range of roughly (70-127 mm), as required by claims 11 and 12, noting that a distance of 69 mm is explicitly shown and an additional distance beyond the 69 mm that is shown may be extrapolated as being roughly 20 mm. Last, Hasebe acknowledges that the added mass should weigh about 9 grams, thereby satisfying the claimed requirements that the weight be between 5 and 25 grams. Here again, Hasebe teaches that selectively placing added weights in a hollow metal club head affects the ball flight upon impact. In view of the patents to Vincent and Hasebe, it would have been obvious to modify the device in the cited art reference to Teramoto by arranging the weights in locations including combinations of the heel, toe, sole and crown and dimensioning the weights to desirably affect the location of the center of gravity which in turn affects the flight of a struck ball.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Helmstetter and Rigal show hollow club heads having diverse

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arrangements of weights placed therein. Cissel, Lezatte and Bouquet show weight-forward designs for wood type club heads.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S. Passaniti/sp  
December 9, 2004